



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,361	12/01/2000	Robert Bible, JR.	11298.4	4116

7590 04/07/2003

NEIL K. NYDEGGER
NYDEGGER & ASSOCIATES
348 Olive Street
San Diego, CA 92103

EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,361

Applicant(s)

BIBLE, ET AL.

Examiner

Jalatee Worjloh

Art Unit

3621

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: .

DETAILED ACTION

1. Claims 1-20 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 11, and 17 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. That is, these claims are not explicitly in the technology arts; the body of the claims must include hardware.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2002/0112171 to Ginter et al.

Referring to claims 1, 3, and 9, Ginter et al. disclose decrypting a first part (i.e. “permission record”) of said file using a first key, ascertaining a second key (i.e. “decryption key”) from said first part of said file during said decrypting step, and employing said second key to decrypt a second part (i.e. “the content”) of said file for use in revealing said second part;

Art Unit: 3621

wherein said first key is a public key provided by a transaction agent and said second key is a private key; wherein said second part is a content (see paragraphs [1056]; [1058], lines 20-24; [1194]; and Figures 17 & 18). Note. Paragraph [1056] indicates that the permissions record (i.e. “first part”) stores decryption keys (i.e. “second key”) for accessing the encrypted content. The examiner presumes that these decryption keys may include a private key. Also, paragraph [1058] states that permissions record and key blocks can be encrypted with a private key. This system supports Public-Key encryption; thus, since the permissions record (i.e. “first part”) is encrypted with the private key it must be decrypted with the public key (see paragraphs [1533], [1534]).

Referring to claim 2, Ginter et al. disclose presenting said file on the Internet, selecting said file from the Internet [1762], and sending said first part of said file to a transaction agent (i.e. “clearinghouse”) for accomplishment of said decrypting step and said ascertaining step (see paragraph [1087] and fig. 21).

Referring to claims 4, 5 14 and 15, Ginter et al. disclose the method wherein said employing step is accomplished by said transaction agent and a buyer (see paragraph [1087], and Fig. 21). Note. Administrative objects 870 comprises the permission record 808 (i.e. “first part”) and the content 812 (i.e. “second part”); these objects “are sent between two VDE nodes, for example, a VDE clearinghouse service, distributor, or client administrator and an end user’s electronic appliance”, which in turns decrypts the permissions records and then the encrypted content. Thus, any node (see fig. 1), including transaction agent or the buyer can perform the employing step.

Referring to claim 6, Ginter et al. disclose the method wherein said file periodically changed (see [2164]. Note. Ginter et al. disclose “periodical publication” which implies that the file is periodically changed.

Referring to claim 7, Ginter et al. disclose the method wherein said first part is an overhead including said second key and having commercial material about said file, said commercial material including pricing and payment terms (see paragraph [1903]).

Referring to claim 8, Ginter et al. disclose the method further comprising a header having advertising material about said second part and information material about a seller (see paragraph [2170]).

Referring to claim 10, Ginter et al. disclose the method wherein the content includes works elected forma group consisting of books, documents, pamphlets, movies, songs, games, pictures and software (see paragraph [1085], lines 1-10).

Referring to claim 11, Ginter et al. disclose presenting a file, said file being created by the seller and containing at least an overhead and a content, said overhead being encrypted with a first key and at least a portion of said content being encrypted with a second key, decrypting said overhead of said file by employing said first key to ascertain said second key, and decrypting said content of said file by employing said second key to reveal said file for use by said buyer (see figs. 1, 17, 18; paragraphs [0378], [0137], [1056]; [1058], lines 20-24; [1087], and [1194]).

Referring to claims 12, Ginter et al. disclose the method wherein the presenting step is accomplished on an Internet (see paragraph [1762]), and further wherein said first key is a public key said second key is a private key (see paragraph [1058], lines 20-24). Note. Paragraph [1056] indicates that the permissions record (i.e. “first part”) stores decryption keys (i.e. “second

key”) for accessing the encrypted content. The examiner presumes that these decryption keys may include a private key. Also, paragraph [1058] states that permissions record and key blocks can be encrypted with a private key. This system supports Public-Key encryption; thus, since the permissions record (i.e. “first part”) is encrypted with the private key it must be decrypted with the public key (see par

Referring to claim 13, Ginter et al. disclose the method wherein said step of decrypting said overhead to ascertain said second key is accomplished by said transaction agent, i.e. “clearinghouse” (see paragraph [1087] and fig. 21).

Referring to claims 16 and 19, Ginter et al. disclose the method wherein said overhead includes said second key and commercial material about said file, said commercial material including pricing and payment terms, and further wherein said content includes work selected from a group consisting of books, documents, pamphlets, movies, songs, games, pictures and software (see paragraphs [1903]; [2170]; [1085], lines 1-10).

Referring to claims 17 and 18, Ginter et al. disclose a transaction agent, a public key, a private key, a seller for creating said file and publishing said file on the Internet, said file having at least a first part and a second part with said first part being encrypted using said public key and said second part being encrypted with said private key; and a buyer for selecting said file from the Internet and sending said first part of said file to said transaction agent for decryption thereof by said transaction agent using said public key to ascertain said private key for subsequent use in decrypting said revealing said second part of said file for use by said buyer; wherein said private key is provided by said seller (see figs. 1, 17, 18; paragraphs [0378], [0137], [1056]; [1058], lines 20-24; [1087], and [1194], [1762]). Note. The seller gives request content

Art Unit: 3621

which comprises the permissions record (includes the key) is given to the buyer; thus, the seller provides the private key.

Referring to claim 20, Ginter et al. disclose a buyer's account maintained by said transaction agent for said buyer, a seller's account maintained by said transaction agent for said seller, and means for transferring funds of said value from said buyer's account to said seller's account when said second part of said file is revealed (see paragraphs [0217], [0183]).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to: **Commissioner of Patents and Trademarks, Washington, DC 20231.**


Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

Application/Control Number: 09/728,361

Page 7

Art Unit: 3621

March 31, 2003



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600